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EXAMINER

CARLSON, JEFFREY D

ART UNIT PAPER NUMBER

3622

DATE MAILED: 07/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/887,547

Applicant(s)

CHANG ET AL.

Examiner

Jeffrey D. Carlson

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*NU*

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 3/3/03
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 11-14 are rejected under 35 U.S.C. 101 because the claims do not provide a useful, concrete and tangible result. As best understood, these claims apparently select a subset of files to be sent, but no delivery of the files is accomplished. The claims therefore do not provide a useful, concrete and tangible result.

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 11-17, 20, 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claim 11 section (a) is generally confusing to the examiner. Clarification is requested.
- Claim 11 section (b) – doesn't the client make speed-based data requests for video files stored at the *server*, rather than at the client?

- Claim 11 section (b), there is no antecedent basis for the subdata.
- Claims 13 and 20, it is unclear what "the outside" refers to. The claims are also confusing in that communication via the Internet to the ad server to download the ad content could be taken to be "with the outside," yet data requesting/downloading continues for ad content.
- Claim 15, it is unclear what the difference between the data requesting module and the data calling module is. This claim states that the calling module calls data from the server storage, yet this function is believed to be carried out by the data requesting module.
- Claim 15, there is no antecedent basis for "the corresponding data" or for "the moving picture."

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

4. Claims 1, 2, 4, 8-10, 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Aharoni et al (US6014694).

Regarding claims 1, 18, Aharoni et al teaches concepts for adaptively transporting video over networks such as the Internet. In particular, Aharoni et al

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teaches compression of a video file into several (N) sets of files having different compression rates. Measurement of a video client's connection speed is made and a particular video file set is sent depending on the available bandwidth for the client [col 18, col 13 lines 10-36, fig 15].

Regarding claim 2, 9, the client runs software which sends packet acknowledgments to the server in order to measure the speed. This is taken to provide a client-based measurement/indication of the clients bandwidth/speed.

Regarding claim 4, 10, any video can be taken to be "advertisement" video. The video is taken to be an advertisement for its content. Any video or video scenes can be used as advertisement. There is no particular requirement set forth that defines advertising video from other video. Further, Aharoni et al acknowledges video advertising on the Internet [1:11-15].

Regarding claim 8, Aharoni et al's server identifies a user's measured connection speed and determines a particular file set (compression level) based on such speed. The rate controller chooses the particular file set to send. It is inherent in the system of Aharoni et al that a mapping between required compression level and location of files satisfying such bandwidth characteristics exist in some manner of datastore (i.e. a database determining which file sets are to be used for various bandwidth situations).

5. Claims 5, 6 are rejected under 35 U.S.C. 102(e) as being anticipated by Katinsky et al (US6452609).

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Regarding claims 5 and 6, Katinsky et al teaches a web client displaying a video as well as an advertising banner. While any banner ad shown at the same time as a video is taken to provide synchronization of the banner and video, Katinsky et al teaches that the banner ads are synchronized to the media object (video) [7:20-42]. The video of Katinsky et al is stored locally at least in RAM/cache/buffer.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Katinsky et al in view of Aharoni et al. Katinsky et al does not select video files from the server based upon available bandwidth. Aharoni et al teaches concepts for adaptively transporting video over networks such as the Internet. In particular, Aharoni et al teaches compression of a video file into several (N) sets of files having different compression rates. Measurement of a video client's connection speed is made and a particular video file set is sent depending on the available bandwidth for the client [col 18, col 13 lines 10-36, fig 15]. It would have been obvious to one of ordinary skill at the time of the invention to have chosen particular video file sets based on the client's bandwidth in order to optimize video resolution while balancing available client resources.

7. Claims 12-14, 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aharoni et al in view of Rakavy et al (US6317789).

Regarding claim 12, 14, 19, 21, Aharoni et al does not teach a data list. Rakavy et al however teaches multimedia ads delivered over a network. Rakavy et al teaches use of a resource list which defines all required files needed by the client (plug-ins, DLLs, media players, etc) in order to properly display the multimedia ads. The client is instructed to download all files on the list not already present on the client [7:23-40]. It would have been obvious to one of ordinary skill at the time of the invention to have used such an approach with that of Aharoni et al so that the user can use files already located on his machine and that needed files can be identified and downloaded in order to show the ads. It is well known for computers to "clean up" out of date files, expired cache, etc. It would have been obvious to one of ordinary skill at the time of the invention to have deleted such unnecessary files (i.e. files not on the resource list) in order to recover storage space.

Regarding claim 13, 20, when the client finishes downloading required files, the client is taken to still be "in communication with the outside" (the Internet connection is available). In the case of a dial-up user, a user making a phone call (starts communication with the outside) terminates the Internet connection and therefore terminates any data download.

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8. Claims 3, 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aharoni et al. As stated above, the client includes software functionality to acknowledge packets in order to measure the client speed. It would have been obvious to one of ordinary skill at the time of the invention to have received such packet-reporting software from the ISP/server delivering the video so that the client can be equipped to measure the bandwidth. As best understood, claim 11 is rejected similarly.

9. Claims 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aharoni et al in view of Rakavy et al and Olshansky (6493437).

Regarding claim 15, 16, the video client in Aharoni et al can be any type of GUI-based application that can decode and render video files. Olshansky teaches a web browser client that provides VOIP services and that can display ads [fig 3, 4:37-49]. Olshansky teaches that plural ads can be shown at the same time [5:39-44]. Official Notice is taken that it is well known to provide video ads as well as static banner ads. It would have been obvious to one of ordinary skill at the time of the invention to have rendered the plural ads of Olshansky VOIP client as video as well as banner ads in order to provide a more rich advertising experience. It would have been obvious to one of ordinary skill at the time of the invention to have chosen and downloaded the video ad content based upon the client's measured connection speed as taught by Aharoni et al in order to maximize quality given the constraint of limited resources. As stated above, displaying a banner ad at the same time as a video ad is taken to provide synchronization.

Regarding claim 17, it would have been obvious to one of ordinary skill at the time of the invention to have delivered any type of video ad including one without sound - such would meet claim 17. Further, it would have been obvious to one of ordinary skill at the time of the invention for the user to mute his client/computer/speakers when placing a VOIP call so he can hear the conversation – such meets claim 17. Further still, it would have been obvious to one of ordinary skill at the time of the invention for the client to mute any non\_VOIP sound so that the user can hear his VOIP phone call.

### ***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


- Collins-Rector et al (US6188398) teaches a client which displays video and banner ads.
- Lai et al (US6600737) teaches a VOIP client with displayed ads; the client indicates the speed of connection in order to manage available bandwidth.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 703-308-3402. The examiner can normally be reached on Mon-Fri 8:30-6p, (off on alternate Fridays).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 703-305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jeffrey D. Carlson  
Primary Examiner  
Art Unit 3622

jdc